



03 JUN 2004

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Brown Raysman Millstein Felder & Steiner, LLP  
900 Third Avenue  
New York, NY 10022-4728

In re Application of SIM et al :  
U.S. Application No.: 09/763,338 :  
Int. Application No.: PCT/AU00/00937 : DECISION  
Int. Filing Date: 07 August 2000 :  
Priority Date: 06 August 1999 :  
Attorney Docket No.: 4670/1 :  
For: NETWORK RESOURCE MONITORING AND :  
MEASUREMENT SYSTEM AND METHOD :  
:

This is in response to applicant's "Renewed Petition Under 37 CFR 1.47(a)" filed 26 February 2004.

#### BACKGROUND

On 07 August 2000, applicant filed international application PCT/AU00/00937, which claimed priority of an earlier Australia application filed 06 August 1999. A copy of the international application was communicated to the USPTO from the International Bureau on 15 February 2001. A Demand for international preliminary examination, in which the United States was elected, was filed on 26 February 2001, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 06 February 2002.

On 16 February 2001, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 08 May 2001, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 17 April 2002, applicant filed a petition under 37 CFR 1.47(b).

On 17 May 2002, this Office mailed a decision dismissing the 17 April 2002 petition.

On 16 December 2002, applicant filed a response to the 17 May 2002 decision.

On 30 January 2003, this Office mailed a communication in reply to applicant's 16 December 2002 response.

On 05 September 2002, applicant filed a petition under 37 CFR 1.47(a).

On 21 October 2003, this Office mailed a decision dismissing the 05 September 2002 petition.

On 26 February 2004, applicant filed the present renewed petition under 37 CFR 1.47(a).

### **DISCUSSION**

A petition under 37 CFR 1.47(a) must be accompanied by: (1) an oath or declaration by each applicant on his or her own behalf and on behalf of the nonsigning joint inventors, (2) factual proof that the missing joint inventors refuse to join in the application or cannot be reached after diligent effort, (3) the fee set forth in §1.17(i), and (4) the last known addresses of the nonsigning joint inventors.

Applicant has previously satisfied items (1), (3), and (4) above.

With regard to item (2) above, MPEP 409.03(d) states in relevant part,

Where a refusal to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

The petition states that inventors Lim Or Sim and Yee Han Cheong refuse to sign the application papers. Applicant has sufficiently established that a bona fide attempt was made to present a complete copy of the application papers (including specification, claims, drawings, and oath/declaration) to the nonsigning inventors for signature (see supplemental affidavit of David Moore, ¶¶2-3). Furthermore, applicant has submitted evidence of Sim and Cheong's refusal to sign the declaration (see original affidavit of David Moore). Therefore, it would be reasonable to conclude that inventors Lim Or Sim and Yee Han Cheong refuse to join in the application.

### CONCLUSION

For the reasons above, the petition under 37 CFR 1.47(a) is GRANTED.

This application has an international filing date of 07 August 2000 and a date under 35 U.S.C. 371(c)(1), (c)(2), and (c)(4) of 05 September 2003.

As set forth in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the nonsigning inventors at the last known addresses of record and will be published in the *Official Gazette*.

This application is being forwarded to the United States Designated/Elected Office (DO/EO/US) for further processing in accordance with this decision.



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In re Application of SIM et al  
U.S. Application No.: 09/763,338  
Int. Application No.: PCT/AU00/00937  
Int. Filing Date: 07 August 2000  
Priority Date: 06 August 1999  
For: NETWORK RESOURCE MONITORING AND  
MEASUREMENT SYSTEM AND METHOD

Dear Lim Or Sim and Yee han Cheong:

You are named as joint inventors in the above-captioned United States national stage application, filed under the provisions of 37 CFR 1.47(a) and 35 U.S.C. 116. Should a patent be granted, you will be designated as inventors.

As named inventors, you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost set forth in 37 CFR 1.19) or to make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent agent or attorney presenting written authorization from you. If you choose to join in the application, counsel of record (see below) would presumably assist you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.

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